



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,287	11/03/2003	Rodney Carl Harris	10016459-1	4508

22879 7590 01/03/2008
HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

WILLS, LAWRENCE E

ART UNIT	PAPER NUMBER
----------	--------------

2625

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/03/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

Office Action Summary	Application No. 10/700,287	Applicant(s) HARRIS ET AL.	
	Examiner Lawrence E. Wills	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-25, 35 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-25, 35, 39, 40, 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4,6-8, 10-16, 17-21, 23-25, 35, 39, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sese et al. (US Patent No. 7,221,800).

Regarding claim 1, Sese et al. '800 teaches a method for enabling electronic document ratification (Fig. 6 shows a menu for writing a signature and Fig. 7 shows the signature added to the document), the method comprising: receiving with a printing device an unmodifiable document (A form code is communicated to the digital transmitter device. The form code is used by the digital transmitter device to identify a softcopy of a form template that has one or more predetermined insertion fields, column 3, lines 59-63,) collecting with the printing device handwritten content from a recipient of the document (This input can be a handwritten signature upon a touch sensitive screen. Column 8, lines 51-52); and the printing device adding data

reflective of the handwritten content to the document without replacing original content of the document (The user is prompted to enter the text, or representations thereof, that is to be respectively inserted into the one or more predetermined insertion fields, column 3, lines 63-65).

Regarding claim 2, Sesek'800 teaches wherein receiving an unmodifiable document (form code, column 3, line 59) comprises receiving an unmodifiable document with a multi- function peripheral (MFP) device (digital transmitter device, column 3, line 60) configured to print, copy, scan, and transmit documents (digital transmitter device may be stand-alone devices that have a scanning mechanisms, and output mechanisms such as a printer, copier, or a fax machine, column 7, lines 50-52).

Regarding claim 3, Sesek'800 teaches wherein receiving an unmodifiable document comprises the printing device receiving a PDF file (email attached document e.g. a *.PDF format, column 19, line 44).

Regarding claim 4, Sesek'800 teaches wherein receiving an unmodifiable document comprises the printing device receiving a file that resulted from scanning a hard copy document (the scanning of a hardcopy to produce an optically scanned image at a digital transmitter device, column 4, lines 8-9).

Regarding claim 6, Sesek'800 teaches wherein collecting handwritten content comprises the printing device scanning handwritten content manually handwritten on a printout of the received

unmodifiable document by the recipient (a user can make marks or symbols on the hardcopy that is to be scanned, column 5, lines 52-53).

Regarding claim 7, Sesek'800 teaches wherein scanning handwritten content comprises the printing device only scanning the manually handwritten content (the detectable indica can be an ink that is visible upon application by a user to a paper document, column 4, lines 42-44. Upon this determination respective text is located, identified, and/or retrieved, column 4, lines 21-22).

Regarding claim 8, Sesek'800 teaches wherein only scanning the manually handwritten content comprises the printing device only scanning handwritten content contained within an input block of the document (the detectable indica can be an ink that is visible upon application by a user to a paper document, column 4, lines 42-44. Upon this determination respective text is located, identified, and/or retrieved, column 4, lines 21-22).

Regarding claim 10, Sesek'800 teaches wherein collecting handwritten content comprises the printing device collecting handwritten marks manually entered by the recipient in a touch-sensitive screen of the printing device (input can be a handwritten signature upon a touch sensitive menu screen, column 8, line 51).

Regarding claim 11, Sesek'800 teaches wherein adding data comprises the printing device adding data within an input block of the unmodifiable document (predetermined insertion fields, column 3, line 62-63).

Regarding claim 12, Sesek'800 teaches at least one of the printing device printing the document after the data has been added, transmitting the document after the data has been added, and storing the document after the data has been added (After these insertions, a modified scanned image of the hardcopy is composed as a document. The composed document can then be output by digital transmitter device. The out put can be made by the document being printed out, transmitted by a facsimile to a facsimile telephone number, or sent in a file. Column 9, lines 4-8).

Regarding claim 13, Sesek'800 teaches, further comprising a sending device sending an unmodifiable document to the printing device (a form code is communicated to the digital transmitter device, column 3, lines 59-60).

Regarding claim 14, Sesek'800 teaches the sending device identifying an input block of the unmodifiable document prior to sending the unmodifiable document (predetermined insertion fields, column 3, lines 62-63).

Regarding claim 15, Sesek'800 teaches the sending device adding metadata to the unmodifiable document that identifies that the document is to be ratified (bar codes places on the hardcopy or its corresponding softcopy, column 5, line 13. A different bar code that is detected by a detection routine may be interpreted as an instruction to prompt a user to make a handwritten mark, column 5, lines 31-34).

Regarding claim 16, Seseek'800 teaches the sending device adding metadata to the unmodifiable document that identifies a location of an input block of the document (These characteristics can include the number, location, size and shape of the one ore more insertion fields. .column 5, lines 7-8)

Regarding claim 17, Seseek'800 teaches a system for enabling electronic document ratification, the system comprising: a sending device configured to transmit an unmodifiable document (Fig. 1a shows 102-2 or 102-3. In addition, 102-i may have an output mechanism such as a fax machine); and a printing device configured to receive the transmitted document (A form code is communicated to the digital transmitter device, column 3, lines 59-60) to collect handwritten content from a recipient of the document and to add data reflective of the handwritten content to the document without replacing original content of the document (The user is prompted to enter the text, or representations thereof, that is to be respectively inserted into the one or more predetermined insertion fields, column 3, lines 63-65).

Regarding claim 18, Seseek'800 teaches, wherein the printing device comprises at least one of a digital sender and a multi-function peripheral (MFP) device (digital transmitter device may be stand-alone devices that have a scanning mechanisms, and output mechanisms such as a printer, copier, or a fax machine, column 7, lines 50-52).

Regarding claim 19, Seseek'800 teaches wherein the printing device comprises a multi-function peripheral (MFP) device configured to print, copy, scan, and transmit documents (digital

transmitter device may be stand-alone devices that have a scanning mechanisms, and output mechanisms such as a printer, copier, or a fax machine, column 7, lines 50-52).

Regarding claim 20, Sesek'800 teaches the printing device comprises a document scanner (digital transmitter device may be stand-alone devices that have a scanning mechanisms, and output mechanisms such as a printer, copier, or a fax machine, column 7, lines 50-52).

Regarding claim 21, Sesek'800 teaches wherein the printing device is configured to only scan the handwritten content (the detectable indica can be an ink that is visible upon application by a user to a paper document, column 4, lines 42-44. Upon this determination respective text is located, identified, and/or retrieved, column 4, lines 21-22).

Regarding claim 23, Sesek'800 teaches the printing device comprises a touch-sensitive screen in which the recipient can manually enter the handwritten content (input can be a handwritten signature upon a touch sensitive menu screen, column 8, line 51).

Regarding claim 24, Sesek'800 teaches wherein the printing device comprises means for adding data within an input block of the document (predetermined insertion fields, column 3, line 62-63).

Regarding claim 25, Seseek'800 teaches the sending device comprises means for adding metadata to the unmodifiable document that identifies at least one of that the document is to be ratified (the form code is used by the digital transmitter device to identify a softcopy of a form template that has one or more predetermined insertion fields, column 3, lines 60-63) and a location of an input block of the document.

Regarding claim 35, Seseek'800 teaches a printing device (number 310 Fig. 2), comprising: a processor (CPU number 202 Fig. 2); a touch-sensitive screen (Touch Sensitive Menu Screen number 210 Fig. 2) configured to receive manually handwritten content entered into the touch-sensitive screen with a stylus (handwritten mark using a styus on a touch sensitive menu, column 5, line 33); and memory (number 206 Fig. 2) including a document ratification manager (image composer number 217), that is configured to receive an unmodifiable document (image composer generates a bit map or other output that is a digital representation of the scanned document, column 12, lines 55-57), to collect handwritten content from a recipient of the document using the touch-sensitive screen (text and/or objects for each insertion field are obtained, column 12, lines 62-63), and to add data reflective of the handwritten content to the document without replacing original content of the document (Once obtained, the text and/or objects are inserted into their respective insertion fields within the bit map or other output, column 12, lines 64-66).

Regarding claim 39, Seseek'800 teaches wherein the document ratification manager is configured to add the data within an input block of the unmodifiable document (Once obtained, the text

and/or objects are inserted into their respective insertion fields within the bit map or other output, column 12, lines 64-66).

Regarding claim 40, Sesek'800 teaches A printing device, comprising: a processor (CPU number 202 Fig. 2); a scanner configured to scan documents containing handwritten content (scanning mechanism number 212 Fig. 2); and memory (number 206 Fig.2) including a document ratification manager (image composer number 217) that is configured to receive an unmodifiable document (image composer generates a bit map or other output that is a digital representation of the scanned document, column 12, lines 55-57), to collect handwritten content from a recipient of the document using the scanner (text and/or objects for each insertion field are obtained, column 12, lines 62-63), and to add data reflective of the handwritten content to the document without replacing original content of the document (Once obtained, the text and/or objects are inserted into their respective insertion fields within the bit map or other output, column 12, lines 64-66).

Regarding claim 41, Sesek'800 teaches wherein the document ratification manager is configured to add the data within an input block of the unmodifiable document (Once obtained, the text and/or objects are inserted into their respective insertion fields within the bit map or other output, column 12, lines 64-66).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sesek et al. (US Patent No. 7,221,800) in view of Adobe Acrobat 4.0 User Guide.

Regarding claim 9, Sesek'800 fails to teach wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received unmodifiable document.

However, Adobe Acrobat 4.0 User Guide teaches wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received unmodifiable document (Document compare lets you open two or more Adobe PDF files in tiled windows for side-by-side on-screen comparison of different versions of a document. More importantly, the feature lets you "rollback" among versions of a document to see what changes have been made between digital signatures, page 3).

Having a system of Sesek'800 reference and then given the well-established teaching of Adobe Acrobat 4.0 User Guide reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Sesek'800 reference as taught by

Adobe Acrobat 4.0 User Guide reference, since Adobe Acrobat 4.0 User Guide reference suggested streamlining the document review process (page 3).

Regarding claim 22, Seseek'800 fails to teach wherein the printing device is configured to compare scanned data with data of the transmitted document.

However, Adobe Acrobat 4.0 User Guide teaches wherein scanning handwritten content comprises the printing device scanning an entire printout of the document and comparing data obtained through the scanning with data of the received unmodifiable document (Document compare lets you open two or more Adobe PDF files in tiled windows for side-by-side on-screen comparison of different versions of a document. More importantly, the feature lets you "rollback" among versions of a document to see what changes have been made between digital signatures, page 3).

Having a system of Seseek'800 reference and then given the well-established teaching of Adobe Acrobat 4.0 User Guide reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Seseek'800 reference as taught by Adobe Acrobat 4.0 User Guide reference, since Adobe Acrobat 4.0 User Guide reference suggested streamlining the document review process (page 3).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence E. Wills whose telephone number is 571-270-3145. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM EST.

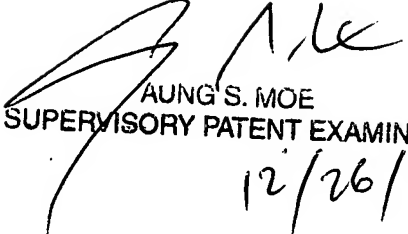
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number:
10/700,287
Art Unit: 2625

Page 13

LEW
December 20, 2007


AUNG S. MOE
SUPERVISORY PATENT EXAMINER
12/26/07